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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/810,159 | 03/19/2001 | Shuwu Wu | 06975-099001 | 9046 |

26171 7590 06/15/2005

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| EXAMINER |
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NGUYEN, TRONG NHAN P

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| ART UNIT | PAPER NUMBER |
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2152

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/810,159 | WU ET AL. | |
| | Examiner | Art Unit | |
| | Jack P. Nguyen | 2152 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) 27-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s).

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/2/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Applicant's RCE filed on 5/11/05. Claims 27-36 are canceled. Claims 1-26 and 37-40 are being examined.

Response to Arguments

Applicant's arguments filed on 5/11/05 have been fully considered but are moot based on new grounds of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-26 is rejected under 35 U.S.C. 101 because they are claiming non-statutory subject matter. A propagated signal, as recited in the specification, is a non-statutory computer readable medium.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8, 10-26, and 37-40 are rejected under 35 U.S.C. 102(e) as anticipated by Morris et al, WO 00/60809 (Morris hereafter).

As per claim 1, Morris teaches a communications method comprising:
establishing a text instant messaging 'IM' communication session between a sender (page 3, lines 19-23; after callee accepts a call request from the caller, an IM session is established between the two users; the users can send each other voice and/or text IM messages); facilitating a text instant message to be sent from the sender to the recipient during the session (page 3, lines 19-23; page 3, line 31 – page 4, line 3; after an IM session is established between the users, the users can send each other voice and/or text IM messages; the system can process both voice and text instant messaging between the users simultaneously; instant messaging is now referred to both voice and text instant messages being sent/received by the users); enabling presentation of a first text instant messaging graphical user interface 'GUI' to the recipient that includes an icon and a display of the text instant message, the presentation of the first text instant messaging graphical user interface being conditioned on whether the text instant messaging communication session is established between the sender and the recipient (page 3, lines 24-27; using the GUI interface, the users can click a button (or icon) to initiate text/voice instant messaging with each other); and enabling manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient through the instant messaging host (page 3, lines 24-31; as stated above, the users can also click on the icon to initiate voice/text instant messaging with each other) .

Claims 21, 22 and 40 recite similar limitations to claim 1; therefore, they are rejected for similar reasons as claims 1 addressed above.

As per claims 2-4, Morris teaches receiving and authenticating the text instant message from the sender at the instant messaging host (page 7, lines 11-15; instant messaging server, via its database server (250, fig. 2) validates and authenticates the users when sending instant messages between each other); authenticating the text instant message comprises identifying a screen name (page 7, lines 11-15; page 11, lines 26-27; users are authenticated by identifiers such as user names (or screen names); instant messaging server (1, fig. 1) validates and verifies usernames and passwords of users for authentication); and identifying an IP address associated with the sender (page 6, lines 21-23; firewall (234, fig. 2) verifies and authenticates IP addresses of the users in order to allow the users to access the system).

As per claims 5-8, Morris teaches determining hardware and software (including voice communication) capabilities of the recipient and sender at the instant messaging host (page 12, lines 7-13; page 13, lines 11-18; instant messaging server stores the authorized user profile information that includes capabilities (hardware and software) of the terminals authorized to access the system; the users can engage in voice/text instant messaging with each other; i.e., authorized users have the necessary software and hardware to conduct these modes of instant messaging with each other; the user, via its GUI (fig. 8) can see the capabilities of other users (811, fig. 8; capabilities of the users is indicated by the telephone symbol)).

As per claims 10-12, Morris teaches receiving at the instant messaging host, a request to establish voice communication and the request is from the sender (or caller) or recipient (or callee) (page 7, lines 6-10; instant messaging host (240, fig. 2; audio server functions as a voice/text instant messaging server) receives instant messaging request from plurality of users (any user can be caller or callee depending on the condition of the call)).

Claims 13-15 recite similar limitations as claims 2-4; therefore, they are rejected by similar rationale as those claims.

As per claim 16, Morris enabling voice communication comprises establishing a generic signaling interface channel, a control channel, and an audio channel between the sender and the recipient (406, fig. 6, page 11, lines 4-6; instant messaging server establishes voice communication via interface, control (communication), and audio channels).

As per claims 17-20, Morris discloses attempting UDP test on audio channel, audio channel comprises UDP or TCP channel, and control channel comprises TCP/IP socket (page 9, lines 19-23; UDP or TCP are part of the TCP/IP suite of protocols that allows data to be transmitted over the Internet; these protocols can be used to test or transmit data from sender to recipient over the Internet).

As per claims 23-26, Morris teaches the computer readable medium is a client or host device, disc or propagated signal (240, 216, fig. 2; client or host devices comprise a disc for which data can be stored on; data is carried by propagated signal).

Claims 37-39 are rejected by similar reasons as claim 1 addressed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris in view of Sekiguchi et al, 5,848,134 (Sekiguchi hereafter).

As per claim 9, Morris does not explicitly disclose presenting a second text instant messaging interface to the sender that varies according to the capabilities of the recipient. In a related art to the claimed invention, Sekiguchi teaches a system that allows instant voice and text messaging between users (see fig. 1, lower left feature 'Simultaneous Transmission of Live Speech and Data Performed'; col. 3, lines 6-15; user A (2, fig. 1) can chat and talk to user C (6, fig. 1) via a computer and microphone). Sekiguchi further discloses when users log into the IM server (1, fig. 1) to send text/voice IM data to each other, the users see the capabilities of other users as indicated by the picture icons (fig. 5b, col. 9, lines 29-31; user A (PC capability) can see user C (cell phone capability) and vice versa). Thus Sekiguchi discloses the text instant messaging interfaces of the PC and the cell phone users are varied from each other. Hence, it would have been obvious to one of ordinary skill in the art to combine and modify the teachings of Morris and Sekiguchi to allow the users to see the capabilities of other user devices so the user can know the type of data to send/receive from other

users; i.e., the PC user would have been motivated not to send a large multi-media file to the cell phone user because the cell phone user may not have the necessary software nor bandwidth to view the data.

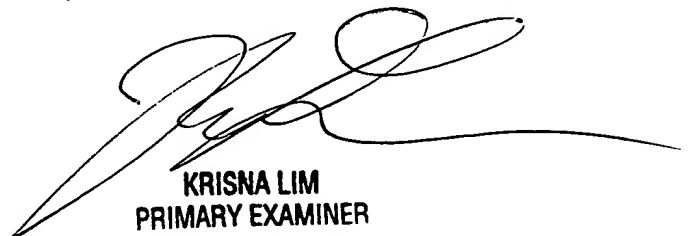
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack P Nguyen whose telephone number is (571) 272-3945. The examiner can normally be reached on M-F 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jpn



KRISNA LIM
PRIMARY EXAMINER